



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/502,014	07/20/2004	Tsukasa Aga	Q82625	8458
23373	7590	11/28/2007	EXAMINER	
SUGHRUE MION, PLLC			CHEUNG, WILLIAM K	
2100 PENNSYLVANIA AVENUE, N.W.				
SUITE 800			ART UNIT	PAPER NUMBER
WASHINGTON, DC 20037			1796	
			MAIL DATE	DELIVERY MODE
			11/28/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/502,014	Applicant(s) AGA, TSUKASA	
	Examiner William K. Cheung	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 9-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 9-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>102607</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Request for Continued Examination

1. The request filed on September 10, 2007 for a Request for Continued Examination (RCE) under 37 CFR 1.53(d) based on parent Application No. 10/502,014 is acceptable and a RCE has been established. An action on the RCE follows.
2. In view of the amendment filed September 10, 2007, claims 2-8 have been cancelled, and new claims 11-12 have been added. Claims 1, 9-12 are pending.
3. The examiner acknowledges the receipt of the IDS filed October 26, 2007, and has considered the references cited in said IDS for the instant US patent application.
4. In view of argued "unexpected results" to show the criticality of the claimed non-ionic surfactant having specific isotridecyl group, the rejection of Claims 1, 9, 10 under 35 U.S.C. 103(a) as being unpatentable over Oharu et al. (U.S. Patent No. 6,610,775), is withdrawn.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent

and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1, 9-12 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of copending Application No. 10/544,525. Although the conflicting claims are not identical, they are not patentably distinct from each other because the water-repellent composition invention of claims 1-6 of copending Application No. 10/544,525 fully encompasses the invention of claims 1, 9-12 as claimed. It would be difficult to one of ordinary skill in art to recognize the process for preparing the composition as claimed after reading the examples 1-5 of copending Application No. 10/544,525.

7. Claims 1, 9-12 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 of copending Application No. 10/579,217. Although the conflicting claims are not identical, they are

not patentably distinct from each other because the water-repellent composition invention of claims 1-8 of copending Application No. 10/579,217 fully encompasses the invention of claims 1, 9-12 as claimed. It would be difficult to one of ordinary skill in art to recognize the process for preparing the composition as claimed after reading the examples 1-5 of copending Application No. 10/579,217.

8. Claims 1, 9-12 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of copending Application No. 10/579,216. Although the conflicting claims are not identical, they are not patentably distinct from each other because the water-repellent composition invention of claims 1-11 of copending Application No. 10/579,216 fully encompass the invention of claims 1, 9-12 as claimed. It would be difficult to one of ordinary skill in art to recognize the process for preparing the composition as claimed after reading the examples 1-5 of copending Application No. 10/579,216.

9. Claims 1, 9-12 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 of copending Application No. 10/290,155. Although the conflicting claims are not identical, they are not patentably distinct from each other because the water-repellent composition invention of claims 1-8 of copending Application No. 10/290,155 fully encompass the invention of claims 1, 9-12 as claimed. It would be difficult to one of ordinary skill in art

to recognize the process for preparing the composition as claimed after reading the example 1 of copending Application No. 10/290,155.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Double Patenting

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 1, 9-12 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 7,015,275.

Although the conflicting claims are not identical, they are not patentably distinct from

each other because the water- and oil- repellent composition invention of claims 1-4 of U.S. Patent No. 7,015,275 fully encompass the invention of claims 1, 9-12 as claimed. It would be difficult to one of ordinary skill in art to recognize the process for preparing the composition as claimed after reading the Table A (col. 7-8) of U.S. Patent No. 7,015,275.

12. Claims 1, 9-12 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6,699,914. Although the conflicting claims are not identical, they are not patentably distinct from each other because the water- and oil- repellent composition invention of claims 1-8 of U.S. Patent No. 6,699,914 fully encompass the invention of claims 1, 9-12 as claimed. Applicants must recognize that claim 1 of U.S. Patent No. 6,699,914 clearly claim a composition comprising cationic and ionic surfactants that generically fully encompass the invention of claims 1, 9-12 of instant application as claimed.

13. Claims 1, 9-12 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6,753,376. Although the conflicting claims are not identical, they are not patentably distinct from each other because the water- and oil- repellent composition invention of claims 1-8 of U.S. Patent No. 6,753,376 fully encompass the invention of claims 1, 9-12 as claimed. Applicants must recognize that claim 6 of U.S. Patent No. 6,753,376 clearly claim a

composition comprising cationic and ionic surfactants that generically fully encompass the invention of claims 1, 9-12 of instant application as claimed.

14. Claims 1, 9-12 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,894,106. Although the conflicting claims are not identical, they are not patentably distinct from each other because the water- and oil- repellent composition invention of claims 1-9 of U.S. Patent No. 6,894,106 fully encompass the invention of claims 1, 9-12 as claimed. Applicants must recognize that claim 1 of U.S. Patent No. 6,894,106 clearly claim a composition comprising cationic and ionic surfactants that generically fully encompass the invention of claims 1, 9-12 of instant application as claimed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William K. Cheung whose telephone number is (571) 272-1097. The examiner can normally be reached on Monday-Friday 9:00AM to 2:00PM; 4:00PM to 8:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David WU can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Application/Control Number:
10/502,014
Art Unit: 1796

Page 8

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



William K. Cheung

WILLIAM K. CHEUNG
PRIMARY EXAMINER

Primary Examiner

November 23, 2007